



D-1112 R1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Enright, et al.)
Application No.: 09/414,290)
Confirmation No.: 3095)
Filed: October 7, 1999)
Title: Remote Viewing of ATM)
Transaction Records)

Art Unit 3628

Patent Examiner
Timothy Harbeck

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the rejections in the above-identified application (as presented in the Office Action dated March 30, 2006).

No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reason that the rejections are not legally valid because the applied references do not render the claims obvious.

Claim Status

Claims 1-43 are pending, with claims 1, 38, and 41 being independent.

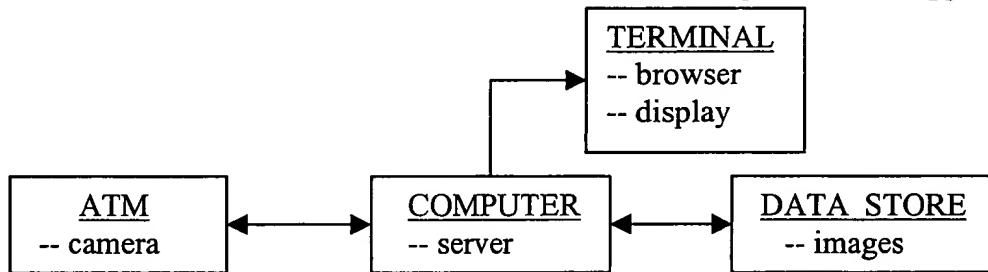
Claims 1-9, 13, 17, 22, and 25-43 were rejected under 35 U.S.C. § 103(a) as obvious over Eisenberg (US 5,354,974) in view of the article *Java goes full circle*, Bank Technology News, 12/1996 (hereafter "Java").

Claims 10-11, 14-16, 18-21, and 23-24 were rejected under 35 U.S.C. § 103(a) as obvious over Eisenberg in view of Java and Hoang (US 6,014,183).

Claim 12 was rejected under 35 U.S.C. § 103(a) as obvious over Eisenberg in view of Java and Hoang and Wookey (US 6,023,507).

The Rejection

As best understood, the Office alleges (in the Office Action dated March 30, 2006) that it would have been obvious to have modified Eisenberg with Java to have produced the apparatus:



Claim 1

Appellants respectfully disagree with the features attributed to the references. Nor would their combination have been obvious, as alleged. The Office has not established a *prima facie* case of obviousness. For example, neither reference teaches or suggests the following features:

1. A computer/server that stores camera image data in a data store responsive to the automated banking machine carrying out a transaction function.
2. A terminal browser that communicates with the server to access the image data from the data store.

Feature 1

1A. Eisenberg doesn't store image data in the manner recited. He teaches away from storing captured camera image data in a server data store. He sends a live (not previously stored) video feed from the ATM camera to the police (col. 2, lines 1-3). The police rely on the timeliness of the information provided by the live video. One having ordinary skill in the art (including Eisenberg) would have recognized that it would not have been obvious to also transmit the video from the ATM to a central data store, especially when the police already have a copy of the video. Nor would there be any need for such transmission due to lack of robberies at the ATM. Conversely, a high rate of robbery at any ATM would result in the ATM being relocated. Economics alone teaches away from the alleged modification. The assertion that Eisenberg's "central computer would almost certainly contain a storage device for . . . video and audio information obtained by the camera for security purposes" lacks concrete evidence of record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). A rejection must be based on evidence of record, not unsupported assertions. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Java doesn't store image data, especially image data captured by a camera at an ATM. At best, Java conventionally stores transaction data.

1B. Eisenberg teaches away from storing image data responsive to the ATM carrying out a transaction function. Conversely, Eisenberg specifically teaches actuating the camera (6) in response to a message from the remote central computer (10) (col. 3, lines 13-14 and 50-51).

Java doesn't store image data, let alone in response to an ATM transaction function.

Feature 2

2A. Eisenberg teaches away from a terminal browser. The Office (on Action page 4) admits that Eisenberg does not teach or suggest that a "user terminal includes a browser".

Java teaches away from a terminal browser. Java's ATM has the browser, not a terminal. Java doesn't even teach or suggest a terminal.

2B. Eisenberg teaches away from a terminal browser communicating with a server (in operative connection with a data store) to access image data stored in the data store. The Office (on Action page 4) admits that Eisenberg does not disclose "a server in operative connection with a data store"; "a communication network in operative connection with the server"; and a "user terminal communicates with the server through the browser". Also, Eisenberg's police are "dispatched immediately to the ATM" (e.g., col. 1, last line) and depend on live video from the ATM camera, not stale video from a data store.

Again, Java does not teach or suggest storing image data or a terminal browser. Nor does Java teach or suggest accessing image data stored in a data store (via a terminal browser), especially image data that was captured responsive to machine transaction function operation.

Thus, Appellants have shown that the references do not teach or suggest *all* of the recited features and relationships. The Office has not established a *prima facie* case of obviousness. Hence, even if somehow combined, the result would not have produced the recited apparatus.

Claim 38

It would not have been obvious to have modified Eisenberg as alleged. Nor would a modified Eisenberg have produced the recited invention. The Office has not established a *prima facie* case of obviousness. For reasons previously discussed, the references at least do not teach or suggest:

1. A computer that can, in response to operation of a selected ATM function device, store (on a first date) camera image data in a data store.
2. A networked remote terminal (in operative connection with the data store) that can access (on a second date) the stored image data and display the images.

Claim 41

It would not have been obvious to have modified Eisenberg as alleged. Nor would a modified Eisenberg have produced the recited invention. The Office has not established a *prima facie* case of obviousness. For reasons previously discussed, the references at least do not teach or suggest:

1. A computer that causes camera image data to be stored (at a first time) in a data store responsive to the ATM carrying out a transaction function, where a server is in operative connection with the data store.
2. A networked remote terminal that can communicate with the server to access (on a second date) the stored image data.

Conclusion

Appellants respectfully submit that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029

WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000
Customer No. 28995